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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MATHEW P. J. BAKER and TIMOTHY J. MOULSLEY

Appeal 2009-010945
Application 10/523,940
Technology Center 2400

Before ALLEN R. MacDONALD, ROBERT E. NAPPI, and
CARL W. WHITEHEAD, JR., *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL[1]

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF CASE

Introduction

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 1-25. We have jurisdiction under 35 U.S.C. § 6(b).

Exemplary Claim

Exemplary independent claim 1 under appeal reads as follows:

> 1. A communication system having a downlink indicator channel for transmission of an indicator signal indicating that a data packet is scheduled to be transmitted on a downlink data channel from a primary station to a secondary station, the secondary station having receiving means for receiving the indicator signal and the data packet, and acknowledgement means for transmitting a signal to the primary station to indicate the status of the received data packet, wherein the secondary station comprises means for transmitting on an uplink channel a status signal to indicate receipt of the indicator signal before transmission of a positive or negative acknowledgement to indicate the status of the received data packet.

Rejections

1. The Examiner rejected claims 1-6, 13-17, 19-22, 24, and 25 as being unpatentable under 35 U.S.C. § 103(a) over the combination of Padovani (US 2003/0063583 A1) and Diachina (US 5,633,874).

2. The Examiner rejected claim 7 as being unpatentable under 35 U.S.C. § 103(a) over the combination of Padovani, Diachina, and Wang (US 5,933,763). [2]

3. The Examiner rejected claim 8 as being unpatentable under 35 U.S.C. § 103(a) over the combination of Padovani, Diachina, and Shi (US 6,320,855 B1).

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[2] Separate patentability is not argued for claims 2-25.

4. The Examiner rejected claims 9 and 11 as being unpatentable under 35 U.S.C. § 103(a) over the combination of Padovani, Diachina, Shi, and Rune (US 6,434,396 B1).

5. The Examiner rejected claims 18 and 23 as being unpatentable under 35 U.S.C. § 103(a) over the combination of Padovani, Diachina, Shi, and Rune.

6. The Examiner rejected claims 10 and 12 as being unpatentable under 35 U.S.C. § 103(a) over the combination of Padovani, Diachina, Shi, and Khan (US 2002/0064167 A1).

Appellants' Contentions

Appellants contend that the combination of Padovani and Diachina fails to teach or suggest "transmitting on an uplink channel a status signal to indicate receipt of the indicator signal before transmission of a positive or negative acknowledgement to indicate the status of the received data packet" as required by claim 1.

Particularly, at page 17 of the Appeal Brief, Appellants contend that "Padovani fails to disclose, 'transmitting on an uplink channel a status signal to indicate receipt of the indicator signal before transmission of a positive or negative acknowledgement to indicate the status of the received data packet . . .,'"and at page 18 of the Appeal Brief, Appellants contend that "the bit map of Diachina does not indicate the status of a data packet transmitted after the status request."

Issue on Appeal

Whether the Examiner has erred in rejecting claims 1-25 because the references do not teach or suggest the argued limitation of "transmitting on

an uplink channel a status signal to indicate receipt of the indicator signal before transmission of a positive or negative acknowledgement to indicate the status of the received data packet" as required by claim 1?

FINDINGS OF FACT (FF)

1. The Appellants admit that a secondary station for receiving and acknowledging a data packet is known in the prior art. (Spec. 1, ll. 20-32).

2. Padovani teaches that it is know in the prior art, that if a base station has data to transmit to a mobile station the base station sends a paging message addressed to a mobile station on a control channel. (Padovani ¶ [0069]).

3. Padovani teaches that it is know in the prior art that after reception of the paging message by the mobile station, the mobile station then selects a data rate and transmits a DRC message on the DRC channel. (Padovani ¶ [0069]).

4. Padovani teaches that it is know in the prior art that after reception of the DRC message by the base station, the base station then transmits data to the mobile station at the selected data rate. (Padovani ¶ [0070]).

PRINCIPLES OF LAW

> In *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 90 S.Ct. 305, 24 L.Ed.2d 258 (1969), the Court elaborated on this approach. The subject matter of the patent before the Court was a device combining two pre-existing elements: a radiant-heat burner and a paving machine. The device, the Court concluded, did not create some new synergy: The radiant-heat burner functioned just as a burner was expected to function; and the paving machine did the same. The

> two in combination did no more than they would in separate, sequential operation. *Id.*, at 60-62, 90 S.Ct. 305. In those circumstances, "while the combination of old elements performed a useful function, it added nothing to the nature and quality of the radiant-heat burner already patented," and the patent failed under § 103. *Id.*, at 62, 90 S.Ct. 305 (footnote omitted).

KSR International, Co.. v. Teleflex, Inc., 550 U.S. 398, 416-17 (2007).

ANALYSIS

Appellants argue that the Examiner has erred because the combination of Padovani and Diachina fails to teach or suggest "transmitting on an uplink channel a status signal to indicate receipt of the indicator signal before transmission of a positive or negative acknowledgement to indicate the status of the received data packet" as required by claim 1.

Although we agree with Appellants that alone Daichina fails to teach the required limitation. We disagree with Appellants' conclusion that the Examiner has err in rejecting the claims as unpatentable based on these references.

We find that "transmitting on an uplink channel a status signal to indicate receipt of the indicator signal" is known in the prior art. (see FF 3 which teaches the indicator signal as a paging message and the status signal as a DRC message). We find that transmitting a status signal to indicate receipt of the indicator signal before transmission of a data packet is known in the prior art. (FF 4). We find that "transmission of a positive or negative acknowledgement to indicate the status of the received data packet" is known in the prior art. (FF 1).

The claims before us are directed to a device combining a pre-existing status signal (Padovani's "DRC message" which is only sent upon receipt of a paging message) to indicate receipt of an indicator signal (Padovani's "paging message") and a pre-existing positive or negative acknowledgement to indicate the status of a received data packet (prior art as admitted by Appellants). The combination does not create a new synergy. Rather, the pre-existing elements continue to function solely as is conventional in the prior art. While the combination of old elements performed a useful function, it adds nothing to the nature and quality of the elements already known in the prior art.

We conclude that desirability of "transmitting on an uplink channel a status signal to indicate receipt of the indicator signal before transmission of a positive or negative acknowledgement to indicate the status of the received data packet" is obvious over the combination of Padovani and Diachina.

Because our rationale in support of our conclusion of obviousness differs substantially from the rationale of the Examiner, we designate this affirmance as a new ground of rejection.

37 C.F.R. § 41.50(b)

37 C.F.R. § 41.50(b) provides that, "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellants, *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 C.F.R. § 1.197 (b)) as to the rejected claims:

> (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner …
>
> (2) Request rehearing. Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record …

CONCLUSIONS

(1) The Examiner has not erred in rejecting claims 1-25 as being unpatentable under 35 U.S.C. § 103(a).

(2) Claims 1-25 are not patentable.

DECISION

The Examiner's rejections of claims 1-25 under 35 U.S.C. § 103 are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED
37 C.F.R. § 41.50(b)

kis

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